

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Young-Soo, Ahn *et al.*
Appln. No. : 09/992,824
Filed : April 14, 2004
Title : FLAT PANEL DISPLAY WITH INPUT DEVICE

Conf. No. : 5886
TC/A.U. : 2673
Examiner : Jimmy H. Nguyen

Customer No. : 116
Docket No. : ILD-44310

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RENEWED PETITION TO REVIVE UNDER 37 CFR 1.137(b)

Sir:

This petition is filed in response to the decision of February 27, 2008 in response to the petition under the unintentional provisions of 37 CFR 1.137(b) to revive the above-mentioned application. The two-month period for responding to the decision expired on April 27, 2008. Accordingly, applicant respectfully requests and petitions that the response date be extended 5 months, up to and including September 29, 2008. Please charge Deposit Account 160820, File No. ILD-44310 for the 5-month extension of time fee of \$2,230.00.

REMARKS/COMMENTS

The Decision on Petition dated February 27, 2008 indicates that the initial petition filed October 29, 2007 provided the necessary elements for a grantable petition except that it lacked a statement in support of applicant's position that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. This renewed petition is offered as a statement and evidence in support of applicant's position that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Accordingly, reconsideration and granting of the petition are requested.

Petitioner, ATOUCH CO., LTD. ("ATOUCH" or the "Company"), is the prior assignee of U.S. Patent Application No.09/992,824. ATOUCH has since merged into ILJIN DISPLAY CO., LTD. ("ILJIN" or the "Company") and this renewed petition is filed on behalf of ILJIN. ILJIN is a Korean corporation engaged in researching, manufacturing and distributing touch-screen input devices used in various electronic products, such as computers, personal digital assistants, mobile phones and other flat panel display products.

Company's General Background and Decision Structure for Patents

ATOUCH was a small technology venture company established on October 27, 2000 [See attached Certificate of Soo Jung]. At the time of incorporation, ATOUCH had five employees only and the initial capital was about US\$100,000 [See the attached JUNG-Exhibit A showing ATOUCH's Commercial Registry]. Nevertheless, the Company has been focusing on research

and development of advanced technology and competitive products, and has considered patents an important asset of the Company. As a result, the Company had filed more than 50 patents by the end of 2002. [See the attached JUNG-Exhibit B]

From incorporation until now, the Company has maintained substantively five teams, R&D, Manufacturing, QA, Sales & Marketing and Administrative. [See the attached JUNG-Exhibit C showing ATOUCH's Organization Chart as of January 1, 2004] The major responsibilities of the Administrative Team include, among others, management assistance, accounting and financial matters, human resources and patent management. Since the Company is a relatively small company with a small number of employees, all matters not specifically belonging to R&D, Manufacturing, QA or Sales & Marketing teams are handled by the Administrative Team.

From incorporation until now, on average, only two persons have been assigned to the Administrative Team. Including Jung-Yoon Shin who was in charge of Administrative Team during 2003-2004, none of them has been a person having adequate experience regarding the U.S. patent prosecution practice. From 2003 until 2006, Jung-Yoon Shin and Sang-Jae Byun were in charge of the Administrative Team. Mr. Shin majored in business management and Mr. Byun majored in economics. Both of them had a limited understanding of the U.S. patent prosecution practice. Since 2006, Soo Jung has been in charge of the Administrative Team. Mr. Jung majored in business administration at a college. Mr. Jung has only a basic understanding of patents, and is not familiar with the actual practices involving U.S. patent applications. Also, Mr. Jung is not good in English and professional patent terminologies. [See the attached Jung- Exhibit D]

Because of the importance of patents and the small size of the Company, it has been the Company's practice to report all patent-related decisions up to the Company's president.

From 2001 till now, seven people have served as president of the Company, but none of them had sufficient knowledge regarding the U.S. patent prosecution practice. During the relevant time period of 2003-2004, Gwang-Sik Jang was the president of the Company, and his college major was a public administration. [See attached Jung- Exhibit D]

Due to such limited internal capabilities, ATOUCH has been utilizing and relying entirely on outside patent counsels for the Company's patent-related matters. Since 2001, the Company has hired, among others, Patent and Law Office of Lee Keon-Joo, Lee & Kwon Law and Patent Office, HANSHIN International Patent & Trademark Office ("HANSHIN"), and SINJI International Patent Law Firm ("SINJI") from time to time.

So, according to the Company's standard operating procedure regarding patents, whenever a significant invention was made by an employee, the Company consulted with its outside patent counsel to determine whether and where to file a patent application. Once the Company decided to file a patent application, the outside patent counsel retained for the matter took a leading role, prepared all application documentations and instructed the Company to take specific actions (i.e., signing a power of attorney prepared by the patent attorney, paying a filing fee, or signing an assignment form). After a patent was registered, the outside patent counsel

reminded the Company of any payment or fee to make, and the Company made payments as invoiced by the outside patent attorney.

Initial Filing of the U.S. Patent Application

The invention covered by U.S. Patent Application No. 09/992,824 was conceived by two former employees, Young-Soo Ahn and Young-Jin Oh, during their employment at the Company. The Company was assigned all of the rights to the invention, and filed an initial patent application in Korea on January 11, 2001. The Company believed that the invention was very good and valuable, and through consultation with its outside patent counsel, decided to file a PCT application and a U.S. application based on the Korean patent applications (No. 2001-1608 and No. 2001-15850) already filed for the same invention.

In 2001, since the Company had no employee familiar with the U.S. patent filing process and fluent in English, the Company requested Chong Hwa KIM ("KIM"), Korean patent attorney at HANSHIN to handle the U.S. patent application. Subsequently, in or about June 2001, KIM retained Brian S. Steinberger ("STEINBERGER") at the Law Offices of Brian S. Steinberger to prepare the U.S. patent application.

About eight months later, on or about February 21, 2002, KIM informed Gwang-Sik Jang, then president of ATOUCH, that U.S. Patent Application No. 09/992,824 was filed with the USPTO about three month before on November 14, 2001.

Failure to Respond to the Office Action in 2004

The delay in reply that originally resulted in the abandonment was caused by ATOUCH's change of Korean attorneys and resulting failure to receive or understand correspondence reporting the Office Action.

Since its incorporation, the Company has been struggling with various difficulties. Initially, the business was not so successful and the Company recorded huge financial losses. In 2003, the total sales revenue was US\$704,000, but the net loss was US\$1,091,000. [See the attached JUNG-Exhibit E showing ATOUCH's financial information from 2001-2007]

In 2003, the Company was not able to pay on time several account payables including the fees invoiced by KIM. As of July 30, 2003, the total amount of outstanding fees was 27,063,680 Won (approximately US\$27,000) [See attached June- Exhibit F]. On or about August 1, 2003, Jung-Yoon Shin at the Company discussed with KIM the amount of outstanding fees and the Company's payment plan. On or about September 24, 2004, the Company had paid KIM 7,368,698 Won (approximately US\$7,400), and the remaining outstanding fees has been paid in December 2007.

Suddenly, on or about May 27, 2003, KIM sent a letter to STEINBERGER informing that he would no longer be responsible for the US Patent Application No. 09/992,824 and advising STEINBERGER to directly communicate with the Company. [See the attached JUNG-Exhibit G showing KIM's Letter dated May 27, 2003]

The Company was neither aware of the KIM's letter to STEINBERGER, nor informed about the status of the US Patent Application No. 09/992,824 and any immediate or future action to be taken by the Company in connection with the U.S. Patent Application 09/992,824.

To the contrary, even after the KIM's letter to STEINBERGER, KIM had continued to provide the Company with his professional service, continued to send his invoices, and continued to collect the fees from the Company, from time to time. The Company had never terminated KIM's professional service and, at all relevant time, had believed that KIM was still assisting the Company in connection with US Patent Application 09/992,824.

Also, unknown to the Company, USPTO mailed to STEINBERGER a non-final office action on October 6, 2003 and Abandonment for Failure to Respond to Office Action on April 14, 2004. It appears that STEINBERGER sent three letters to the Company informing of the USPTO Office action, the first letter on October 13, 2003 by mail, the second reminder letter on December 23, 2003 by fax and the third letter on January 7, 2004 by fax. [See attached Jung- Exhibits H, I and J]

One of the STEINBERGER's letters was addressed to "12F. Wooree Venture Town, #684-2, Deungchon-Dong, Kangseo-Gu, Seoul 157-030, Korea". However, the Company relocated its office to "6 Floor, Wooree Venture Town" in April 2004, to "5th Floor, Wooree Venture Town" in August 2005, to "7th Floor, Wooree Venture Town" in May 2006, and to its current location, "3rd Floor, Daeji Building" in May 2007.

Gwang-Sik Jang, the president of the Company at the time, has no recollection of receiving these letters. Also, Gwang-Sik Jang was not aware of any due date to respond in connection with the U.S. patent application. Gwang-Sik Jang had received no letter from KIM instructing the Company to take any action regarding the U.S. patent application [See the attached Certificate of ChongSu Seo]. Such lack of knowledge is the main reason for the delay in reply that originally resulted in the abandonment.

The Company learned the KIM's letter to STEINBERGER and the STEINBERGER's letters, for the first time, when the Company's US patent attorney, Rothwell, Figg, Ernst & Manbeck, P.C., obtained them from STEINBERGER, and forwarded them, through SINJI Patent Law Firm, to the Company in July 2008. No such letters were found in the Company's patent files [See the attached Certificate of Joo Mee Kim].

If the Company had known the Office Action and the due date to respond through these letters, there was no reason not to timely respond. In fact, the Korean patent based on the same invention was already granted, and it would not have been difficult to respond to the USPTO action. Although the Company was financially not in good shape, the amount of expected patent application expenses was not significant in consideration of the Company's overall operation size. In fact, since the Company is a technology company and the Company has been endeavoring to secure more funds from outside investors, it would be absurd to abandon any patent weakening the Company's patent portfolio.

Company's Discovery of the Abandonment in 2007

The delay in filing an initial petition to revive the application was caused by ATOUCH's lack of knowledge about the abandonment. The initial petition was then filed about three months after the president of ATOUCH became aware of the abandonment of the application during which, ATOUCH was finding a US attorney, gathering evidence and preparing the petition.

In the beginning of 2007, the Company had disputes with its competitors. In response, in or about March 2007, the Company hired Hans Lee, a Korean patent attorney at SINJI International Patent Law Firm ("SINJI") to thoroughly evaluate its overall patent portfolio. Mr. Young-Soo Ahn at ATOUCH was assigned to assist SINJI.

During such investigation, on or about June 28, 2007, Mr. Young-Soo Ahn reported to the president and Mr. Soo Jung that he just discovered U.S. Patent Application No. 09/992,824 filed by ATOUCH seemed to be a strong and valuable invention, and needed to find out the current status of the U.S. patent application. So, ATOUCH instructed SINJI to find out the current status of the U.S. patent application [See the attached Certificate of Hans Lee].

Subsequently, on or about July 20, 2007, Mr. Hans Lee at SINJI reported back to Jung-Yoon Shin, then president of ATOUCH and Young-Soo Ahn that the U.S. patent application was abandoned but could be revived by filing a petition. Mr. Hans Lee also suggested that a

petition would be a worthwhile effort, and ATOUCH could obtain a very valuable patent by filing adequately amended claims.

Upon discovering the fact, for the first time, that U.S. Patent Application No. 09/992,824 was abandoned, ATOUCH was quite surprised because ATOUCH was never aware of the fact and the Company had no reason to abandon the US patent application. So, on the same date, ATOUCH instructed SINJI to take measures necessary to promptly revive the U.S. patent application.

Thereafter, the Company was informed from SINJI that, on or about October 29, 2007, a petition to revive the US application was filed through Rothwell, Figg, Ernst & Manbeck, P.C. (The USPTO Decision On Petition dated February 22, 2008 indicated that no proper power of attorney was filed for Robert B. Murray of Rothwell, Figg, Ernst & Manbeck. But, the Company was not familiar with the USPTO procedural rules and it did not know that a proper power of attorney document had to be submitted to the USPTO).

Company's Discovery of the USPTO's Denial of its Petition in 2008

The delay in filing this grantable renewed petition was caused by the delay in receiving the PTO's decision on the initial petition, merger of ATOUCH into ILJIN, and time during which the Company was finding another US attorney, gathering evidence and preparing the petition.

Since early 2008, the Company was going through a massive management change, and eventually, the Company was merged into ILJIN Display Co., Ltd. ("ILJIN") on August 1, 2008. The merger was the most significant event for the Company's development since its incorporation, and it was imperative for the Company to successfully implement the merger. So, the president and the Administrative Team had to devote most of their time to the merger and the transition work associated with merger. Particularly, the Administrative Team had to coordinate all patent matters with Mr. ChongSu Seo at the intellectual property team of ILJIN, and Mr. ChongSu Seo, on half of ATOUCH, had been directly communicating with the ATOUCH outside patent counsels regarding the ATOUCH patents. This merger is the main reason for the delay in filing a grantable petition to revive the application.

On or about April 22, 2008, in connection with U.S. Patent Application No. 09/992,824, SINJI Patent Law Firm sent to ChongSu Seo a draft letter authorizing Rothwell, Figg, Ernst & Manbeck, P.C. to contact ATOUCH's former U.S. patent agent, Brian S. Steinberger at the Law Offices of Brian S. Steinberger, P.A. in order to investigate the circumstances surrounding the delay in filing the required reply to the USPTO Office action. On the same date, Mr. Seo had obtained ATOUCH's signature and faxed it to SINJI Patent Law Firm. [See attached Seo Exhibit A]

On or about April 28, 2008, ChongSu Seo received from SINJI Patent Law Firm a copy of the USPTO's Decision on Petition dated February 27, 2008 together with a cover letter dated March 19, 2008 from Joo Mee Kim at Rothwell, Figg, Ernst & Manbeck, P.C. According to the

SINJI's stamp affixed to the document, it appeared that SINJI received it on April 1, 2008 [See the attached Certificate of ChongSu Seo and Seo Exhibits B and C].

Upon learning of the USPTO's denial of the ATOUCH petition, ChongSu Seo immediately discussed it with Mr. Ha-Chul Kim, the current president of ATOUCH, Mr. Soo Jung of Administrative Team at ATOUCH, and Mr. Hans Lee at SINJI Patent Law Firm. On the same date, ATOUCH informed Mr. Hans Lee at SINJI Patent Law Firm that ATOUCH intended to ask for reconsideration after collecting sufficient evidence and to extend the filing due date to further investigate the matter. Later on, ATOUCH was informed by its patent attorneys that the filing due date for a renewed petition was extended to September 27, 2008.

Thereafter, ChungSu Seo together with Soo Jung at ATOUCH, had investigated further why ATOUCH did not respond to the USPTO's office action in 2004. In or about May 2008, ChungSu Seo contacted Chong Hwa KIM at HANSHIN International Patent & Trademark Office ("HANSHIN"), who was the Korean patent attorney handling the matter, to find out the circumstances surrounding the abandonment of US Patent Application No. 09/992,824. But, Mr. KIM was reluctant to provide any information or explanation regarding his involvement with the matter, and refused to provide all his files related to U.S. Patent Application No. 09/992,824.

In or about June 2008, ChungSu Seo obtained copies of all files maintained at SINJI Patent Law Firm regarding the matter, and thoroughly reviewed them together with ATOUCH in preparation for a renewed petition to revive to be filed. On or about August 18, 2008, ChungSu Seo received a lengthy memorandum from Joo Mee Kim at Rothwell, Figg, Ernst & Manbeck

explaining the case laws regarding a petition to revive an unintentionally abandoned application and her analysis of the case.

In or about July 2008, Mr. Hans Lee at SINJI sent to ATOUCH a package of correspondence documents obtained by Joo Mee Kim from STEINBERGER. Through this package, for the first time, the Company discovered that on or about May 27, 2003, KIM sent a letter to STEINBERGER informing that KIM would no longer be responsible for the U.S. Application No. 09/992,824 and advising STEINBERGER to directly communicate with the Company [See the attached Certificate of SOO JUNG].

On or about August 22, 2008, ChongSu Seo called Mr. Gwang-Sik Jang, who was the president of ATOUCH from May 2001 until February 2005, to find out why ATOUCH had failed to respond to the USPTO office action in 2004. As a result, ATOUCH learned that Gwang-Sik Jang did not recall neither instructing Chong Hwa KIM at HANSHIN International Patent & Trademark Office, ATOUCH's Korean patent attorney at the time, to abandon US Patent Application No. 09/992,824, nor receiving any letter directly from the USPTO or from the Law Offices of Brian S. Steinberger, ATOUCH's U.S. patent agent at the time, in connection with U.S. Patent Application No. 09/992,824.

In connection with the ATOUCH's merger into ILJIN, the Company had to coordinate all patent matters with the intellectual property team of ILJIN, and, particularly, the Company's former U.S. patent attorney was replaced with a new U.S. patent attorney recommended by ILJIN. Under the circumstance, the Company has done its best efforts to file this renewed petition as

promptly as possible without any further delay. Thus, the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

Respectfully submitted,
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